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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,302	09/10/2003	Jeffrey M. Ayars	REAL-2007109 (RN126)	5404
61857 7590 04/30/2009 AXIOS LAW GROUP, PLLC / REALNETWORKS, INC 1525 4TH AVE, STE 800 SEATTLE, WA 98101-1648				
EXAMINER				
CHAI, LONGBIT				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/660,302

Applicant(s)

AYARS ET AL.

Examiner

LONGBIT CHAI

Art Unit

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33 and 34 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-23 and 25-31 is/are rejected.
- 7) ☒ Claim(s) 24 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/10/2009 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 1, 8, 11 and 19 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claim(s) recite(s) a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claim(s) is/are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The recited method claim(s) including steps are broad enough that the claim(s) could be completely performed mentally, verbally or without being tied to a machine nor is any transformation apparent. ***Examiner suggests*** to add a new first claim limitation as "configuring a processor to

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perform the steps of:". Any other claims not addressed are rejected by virtue of their dependency.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12 – 14 and 21 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safadi (U.S. Patent 2003/0126086), in view of Lisanke (U.S. Patent 2004/0230806).

As per claim 1, Safadi teaches a method of securing delivering digital media (Safadi: Para [0013] Line 7), the method comprising:

receiving digital media from a first device (Safadi: Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18);

receiving a selection of a plurality of dynamically installable (see Lisanke below) **transcoding modules, including a file format module and at least one of a compression module and an encryption module** (Safadi: Para [0017] Line 16 – 18, Para [0028] Line 1 – 5 and Para [0017] Line 7 – 13: (a) "a transcoder is provided for transcoding the content from an original format to a native format compatible with the consumer device" – Examiner notes "a file format module" must thus be included to achieve the converting function in the DRM system, (b) "the content is then re-encrypted using the native DRM scheme" – Examiner notes "an encryption module" must also be included to achieve the re-encrypting function in the DRM system and (c) "a DRM proxy device receives content incorporating with an original DRM

scheme from a content provider and then converts the original DRM scheme into a native DRM scheme compatible with a particular one of a plurality of consumer devices" – Examiner notes a selection of a plurality of transcoding modules of DRM schemes is required in order to select the a native DRM scheme that can be compatible with a particular one of a plurality of consumer devices).

However, Safadi does not disclose expressly **dynamically installing the transcoding modules**.

Lisanke teaches **dynamically installing the transcoding modules** (Lisanke: Para [0013] Line 1 – 5 and Para [0012] Line 5 – 9; provides a mechanism to dynamically install all applications handling DRM content).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Lisanke within the system of Safadi because (a) Safadi teaches a digital right management system that efficiently and transparently converts the digital data formats used between a content provider and a consumer device in various media players (Safadi: Para [0015] Line 1 – 7, Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0013]), and (b) Lisanke teaches providing an efficient and easy-to-implement mechanism for using a DRM system with various existing media players by dynamically installing all applications handling DRM content (Lisanke: Para [0013] Line 1 – 5 and Para [0012] Line 5 – 9).

dynamically installing the selected plurality of dynamically installable transcoding modules (Safadi: Para [0017] Line 16 – 18, Para [0028] Line 1 – 5 and Para [0017] Line 7 – 13) & (Lisanke: Para [0013] Line 1 – 5 and Para [0012] Line 5 – 9);

transforming the data digital media in accordance with the selected transcoding modules (Safadi: Para [0015] Line 1 – 7, Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12); and

delivering the transformed digital media to a second device (Safadi: Para [0021]
Line 18 – 20 and Para [0028]: a consumer device is qualified as a second device).

As per claim 19, the claim limitations are met as the same reasons as that set forth in the paragraph above regarding to claim 1 with the exception of the features **decrypting said electronic data via a transcoding module** (Safadi: Para [0028] Line 1 – 3); and **re-encrypting said electronic data in accordance with said selected digital rights management transcoding module** (Safadi: Para [0028] Line 1 – 12).

As per claim 8 and 11, the claim limitations are met as the same reasons as that set forth in the paragraph above regarding to claim 1 with the exception of the features **encrypting the reformatted files according to the selected digital rights management transcoding module** (Safadi: Para [0031] Line 3 and Para [0028] Line 1 – 12: for data protection by encrypting the digital data content having consumer device's own unique format); and **transmitting the encrypted files to a plurality of consumers** (Safadi: Para [0021] Line 18 – 20 and Para [0028]).

As per claim 2, 3 and 20, Safadi teaches receiving data digital media encrypted according to a first digital rights management system, wherein the first digital rights management system and selected dynamically installable transcoding modules are different (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: if a consumer device could not decrypt (e.g., the content is encrypted using a different encrypting technique), the device might crash during the decoding / decrypting process and as such all bitstream *MUST* be encoded and guarantee

to decode with a *selected* known decoding technique according to a known consumer device, and one of the selected digital rights management transcoding module, as taught by Safadi, is depending upon an unique / particular type of native DRM scheme associated with a given consumer device (from a plurality of user devices), which is *different* from the original type of DRM scheme used by a content provider when downloading a digital media) & (Lisanke: Para [0013] Line 1 – 5 and Para [0012] Line 5 – 9).

As per claim 5 and 6, Safadi teaches a consumer / operator selects said plurality of transcoding modules (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: if a consumer device could not decrypt (e.g., the content is encrypted using a different encrypting technique), the device might crash during the decoding / decrypting process and as such all bitstream *MUST* be encoded and guarantee to decode with a *selected* known decoding technique according to a known consumer device, and one of the selected digital rights management transcoding module, as taught by Safadi, is depending upon an unique / particular type of native DRM scheme associated with a given consumer device (from a plurality of user devices), which is *different* from the original type of DRM scheme used by a content provider when downloading a digital media).

As per claim 7, Safadi teaches a driver module is configured to select said plurality of transcoding modules (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: **Examiner notes** a driver module is merely a software module that performs code / data translation in accordance with an input / output file format compatible with an input / output device).

As per claim 9, Safadi teaches decrypting the at least one file in accordance with the first digital rights management system prior to reformatting the at least one file via a transcoding module

(Safadi: Para [0028] Line 1 – 12: **Examiner notes** a driver module is merely a software module that performs code / data translation in accordance with an input / output file format compatible with an input / output device).

As per claim 10, Safadi teaches using the dynamically-created format transcoding module or writer transcoding module to reformat the files (Safadi: Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: using a dynamically-created format to match with the type used by the consumer device) & (Lisanke: Para [0013] Line 1 – 5 and Para [0012] Line 5 – 9).

As per claim 16 (& Claim 15), Safadi teaches decrypting the input data according to the rules of the second digital rights management system via a transcoding module (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12).

As per claim 17 (& Claim 18), Safadi teaches a generating digital rights management system rules, and writing the generated digital rights management system rules to the output file according to the first digital rights management technique via a transcoding module (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12).

4. Claims 12 – 14 and 21 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safadi (U.S. Patent 2003/0126086), in view of Lisanke (U.S. Patent 2004/0230806), and in view of Suzuki et al. (U.S. Patent 6,463,445).

As per claim 23 and 27 (& Claim 12 – 14 and 21 – 23 and 25 – 31), the claim limitations are met as the same reasons as that set forth in the paragraph above regarding to claims 1, 8, 11 and 19 with the exception of (a) reciting a “translation driver”, a “transcoding module library” or a “compressing / decompressing technique”. Examiner notes Safadi teaches a translation driver (Safadi: Para [0017] Line 16 – 18: a transcoder module may be provided for transcoding the content from an original format to a native format compatible with the consumer device and as such the transcoder module, as taught by Safadi, is also qualified as a translation driver which is also consistent with the disclosure of the instant specification (SPEC: Para [0027] Line 1 – 2: **Examiner notes a translation driver** is merely a software module that performs code / data translation in accordance with an input / output file format(s) that includes receiving an input file with a file identifier (NOTE: each file must contain a file ID), determining the proper file format and then outputting a new output file with a user desired format).

However, Safadi does not disclose expressly a “transcoding module library” or a “compressing / decompressing technique”.

Suzuki teaches a “transcoding module library” and a “compressing / decompressing technique” (Suzuki: Abstract / Line 1 – 7, Column 12 Line 55 – 67, Column 1 Line 44 – 67, Column 2 Line 38 – 46 and Column 3 Line 38 – 45: providing a transcoding tool library - especially “format conversion” including the encoding format associated with compression technique, used in the multimedia bitstream which is originated by a contents server / provider).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Suzuki within the system of Safadi because (a) Safadi teaches a digital right management system that efficiently and transparently converts the digital data formats used between a content provider and a consumer device (Safadi: Para [0015] Line 1 – 7, Para [0017] Line 7 – 12 / Line 16 – 18), and (b) Suzuki teaches providing an effective multimedia information retrieval system including a method for automatic data format conversion by using a transcoding tool library - especially "format conversion" including the encoding format associated with compression technique, used in the multimedia bitstream which is originated by a contents server / provider (Suzuki: Column 12 Line 55 – 67 and Abstract / Line 1 – 7).

Allowable Subject Matter

1. Claims 24 and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims according to the previously Office action submitted on 6 August 2008.
2. Accordingly, claim 33 and 34 which are newly added claims filed on 12 March 2009 are also allowable since the same language recited in these claims would be allowable subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LONGBIT CHAI whose telephone number is (571)272-3788. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Longbit Chai/

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Primary Examiner, Art Unit 2431
4/16/2009